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09/894,476	06/28/2001	Andrew Comas	72167.000564	5938
21967	7590	10/04/2010	EXAMINER	
HUNTON & WILLIAMS LLP			GRAHAM, CLEMENT B	
INTELLECTUAL PROPERTY DEPARTMENT			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/894,476	COMAS ET AL.
Examiner	Art Unit	
Clement B. Graham	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 1/28/10.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/ are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. Claims 1-12 remained pending in this Application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. System claim 10, is rejected because the claimed invention is not supported by either a clearly asserted utility or a well established utility because the claimed invention is drawn to an interface which is software. Therefore, the claims are inoperative and hence lack utility.

Software is not patentable subject matter. Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. (MPEP 2106.01, I).

3. Claim 11 is rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. Independent claim 11 is directed to a computer-readable storage medium.

The following is excerpted from the BPAI decision regarding claim 11, which references "Subject Matter Eligibility of Computer Readable Media," Notice of the Director, Jan. 26, 2010; a copy of which is attached for Applicant's convenience:

"The claims broadly cover transient, propagating signals. The Specification is silent as to what the claimed "computer readable medium" covers. Since a claim to a "computer readable

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medium" reasonably broadly covers both forms of nontransitory tangible media and transient, propagating signals, it necessarily covers non-statutory subject matter. This is so because transient, propagating signals are not patentable subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356 (Fed. Cir. 2007). The four categories together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of §101 even if the subject matter is otherwise new and useful. We must therefore determine whether any of the four categories encompass the claims on appeal, and it is appropriate to consider each of the categories in turn. *In re Nuijten*, 500 F.3d at 1354 (Fed. Cir. 2007). Because the scope of the claims is such that they include subject matter not patent-eligible under §101, the claims must be rejected under §101 as covering nonstatutory subject matter.

It is suggested that the preamble of claim 11amended as follows:

"A computer readable storage medium having a computer executable software code teoted thereon, the code for structured development of migration options in a legacy transactional enterprise, the code comprising.

4 Applicant's request for reconsideration of the finality of the rejection of the last Office action dated 9/2/09 is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12, are rejected under 35 U.S.C. 102(e) as being anticipated by Bowman-Amuah US Patent 7, 139, 999.

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As per claim 1, Bowman-Amuah discloses a computer implemented method for structured development of migration options in a legacy transactional enterprise, the method comprising, identifying components of the legacy enterprise, developing risk factors for the components of the legacy enterprise; identifying unmet opportunities, developing risk factors for the unmet opportunities; identifying potential components for the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) developing risk factors for the potential components of the legacy enterprise; with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components and providing by a computer migration options and developing by a computer the migration options (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67 and column 130 lines 61-67 and column 131 lines 1-40).

As per claim 2, Bowman-Amuah discloses wherein the components of the legacy enterprise are selected from the group consisting of hardware or software (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 3, Bowman-Amuah discloses wherein the unmet opportunities are selected from the group consisting of new hardware, new software or new business methods (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and

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column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 4, Bowman-Amuah discloses wherein the potential components for the legacy enterprise are selected from the group consisting of hardware or software (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 5, Bowman-Amuah discloses wherein the potential components for the legacy enterprise include conceptual models of undeveloped capabilities (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 6, Bowman-Amuah discloses wherein the risk factors include multiple variables (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 7, Bowman-Amuah discloses wherein the risk factors are selected from the group consisting of cost or schedule (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 8, Bowman-Amuah discloses wherein the migration options with associated risk factors are selected from the group consisting of existing components or conceptual models of undeveloped capabilities (see column 21 lines 33-40 and column 26 lines 46-65 and column

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27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 9, Bowman-Amuah discloses wherein the associated risks of the migration options are derived from the risk factors for the components of the legacy enterprise, the risk factors for the unmet opportunities, and the risk factors for the potential components of the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 10, Bowman-Amuah discloses computer executable software code transmitted as an information signal, the code for structured development of migration options in a legacy transactional enterprise, the code comprising:

code to capture identity of components of the legacy enterprise;
code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture risk factors for the unmet opportunities, code to capture identity of potential components for the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture risk factors for the potential components of the legacy enterprise and code with associated risks using at least the risk factors for the components the risk factors for the unmet opportunities and the risk factors for the potential providing by a computer migration options and developing by a computer the migration

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options (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67 and column 130 lines 61-67 and column 131 lines 1-40).

As per claim 11, Bowman-Amuah discloses a computer-readable medium having computer executable software code stored thereon, the code for structured development of migration options in a legacy transactional enterprise, the code comprising:

code to capture identity of components of the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67)
code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet code to capture risk factors for the unmet opportunities, code to capture identity of potential components for the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67)

code to capture risk factors for the potential components of the legacy enterprise, and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components providing by a computer migration options and developing by a computer the migration options (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67 and column 130 lines 61-67 and column 131 lines 1-40).

As per claim 12, Bowman-Amuah discloses a programmed computer for structured development of migration options in a legacy transactional enterprise, comprising: a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory; wherein the program code comprises code to capture identity of components of the legacy enterprise code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities, code to capture risk factors for the unmet opportunities (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture identity of potential components for the legacy enterprise, code to capture risk factors for the potential components of the legacy enterprise, and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components providing by a computer migration options and developing by a computer the migration options (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67 and column 130 lines 61-67 and column 131 lines 1-40).

CONCLUSION

Response to Arguments

7. Applicant's arguments filed 1/28/10 have been fully considered but they are moot in view of new grounds of rejections.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art
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September 20, 2010